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Docket No.: M1885.0022/P022-B
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Carlo Dall'Aglia et al.

Application No.: 09/875,137

Confirmation No.: 8044

Filed: June 7, 2001

Art Unit: 2841

For: APPARATUS FOR CHECKING
DIAMETRAL DIMENSIONS OF
CYLINDRICAL PARTS ROTATING WITH
AN ORBITAL MOTION

Examiner: R. Gibson

REQUEST FOR CONSIDERATION OF IDS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Office Communication dated May 1, 2008.¹ The Office is respectfully requested to consider the Information Disclosure Statement that was filed on March 5, 2008. A copy of the IDS is enclosed herewith.

PTO rules say that "[a]n information disclosure statement shall be considered . . . if filed . . . [b]efore the mailing of a first Office action on the merits." 37 C.F.R. § 1.97(b)(3). The March 5 IDS was filed before the mailing of a first Office Action on the merits. Therefore, the IDS should be considered.

¹ An Interference was declared on May 6, 2008, such that proceedings in the present application were suspended. See 37 C.F.R. § 41.103. The Interference was decided, in Applicants' favor, on June 19, 2008.

According to M.P.E.P. § 609.04(b)(I)(A), the phrase “action on the merits,” in Rule 97(b), means “an action which treats the patentability of the claims . . . as opposed to only formal or procedural requirements.” The Office Communication dated January 28, 2008 did not treat the patentability of the claims. It did not contain a rejection, nor did it allow any claims. Therefore, the Communication was not an “action on the merits” within the meaning of Rule 97(b), and there was no other “action on the merits” prior to March 5, 2008. Therefore, the March 5 IDS should be considered under Rule 97(b).

Moreover, even if the January 28 Communication was, in fact, an “action on the merits,” then the March 5 IDS should have been considered under Rule 97(c). The IDS was accompanied by the “fee set forth in § 1.17(p)” [§ 1.97(c)(2)], by way of the fee authorization on page 2 of the IDS. The IDS requested consideration and authorized the Office to charge any fee “which should have been filed” therewith. Therefore, even if the January 28 Communication was, in fact, an “action on the merits,” the IDS was still in full compliance with the applicable rules, and should be considered.

Consideration of the March 5 IDS is respectfully requested. Favorable action on the application is solicited.

Dated: July 29, 2008

Respectfully submitted,

By 

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In re Patent Application of:
Carlo Dall'Aglia et al.

Application No.: 09/875,137

Confirmation No.: 8044

Filed: June 7, 2001

Art Unit: 2841

For: APPARATUS FOR CHECKING THE
DIAMETER OF CRANKPINS ROTATING
WITH AN ORBITAL MOTION

Examiner: R. Gibson

INFORMATION DISCLOSURE STATEMENT (IDS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 CFR 1.56, 1.97 and 1.98, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO/SB/08. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

This Information Disclosure Statement is filed more than three months after the filing date, but before the mailing date of the first Office Action on the merits (37 CFR 1.97(c)). In accordance with 37 CFR 1.98(a)(2)(ii), Applicants have not submitted copies of U.S. patents and U.S. patent applications. Applicants submit herewith copies of foreign patents and non-patent literature in accordance with 37 CFR 1.98(a)(2).

In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as

defined in 37 CFR 1.56(b) exists. In accordance with 37 CFR 1.97(h), the filing of this Information Disclosure Statement shall not be construed to be an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1073, under Order No. M1885.0022/P022-B.

Dated: March 5, 2008

Respectfully submitted,

By 

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Atty Docket No. 885.0022/P022-B

Inventor: Carlo Dall'Aglio et al.

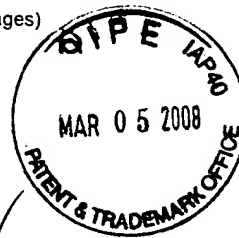
Application No.: 09/875,137-Conf. #8044 Filing Date: June 7, 2001
Title: APPARATUS FOR CHECKING THE DIAMETER OF CRANKPINS ROTATING
WITH AN ORBITAL MOTION

Documents Filed:

Information Disclosure Statement (2 pages)

PTO/SB/08 (3 pages)

29 References Attached



Sender's Initials: TJD/CW/rm

Date: March 5, 2008

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